

REMARKS

Applicant respectfully requests reconsideration of the requirement for restriction imposed in this application in view of the following.

Claims 1-10 are pending in this application and have been subjected to restriction under 35 U.S.C. §§121 and 372 because, in the Examiner's opinion, as set forth in the Detailed Action, the application contains claims directed to 14 patentably distinct inventions as follows:

- I.** Claim(s) 1, drawn to a protein having an amino acid sequence shown in SEQ ID No: 2;
- II.** Claim(s) 2, 3, and 10, in part, drawn to having the sequence shown in SEQ ID NO: 1;
- III.** Claims(s) 3 and 10, in part, drawn to DNA that hybridizes to DNA having the sequence shown in SEQ ID No: 1;
- IV.** Claim(s) 4, drawn to a protein having an amino acid sequence shown in SEQ ID No. 4;
- V.** Claim(s) 5, 6, and 10, in part, drawn to DNA having the sequence shown in SEQ ID No. 3;
- VI.** Claim(s) 6 and 10, in part, drawn to DNA that hybridizes to DNA having the sequence shown in SEQ ID No. 3;
- VII.** Claim(s) 7-8, in part, drawn to microorganisms with amplified copy number of DNA having the sequence shown in SEQ ID No. 1;
- VIII.** Claim(s) 7-8, in part, drawn to microorganisms with amplified copy number of DNA that hybridizes to DNA having the sequence shown in SEQ ID No. 1;

IX. Claim(s) 7-8, in part, drawn to microorganisms with amplified copy number of DNA having the sequence shown in SEQ ID No. 3;

X. Claim(s) 7-8, in part, drawn to microorganisms with amplified copy of DNA that hybridizes to DNA having the sequence shown in SEQ ID No. 3;

XI. Claim(s) 9, in part, to a method of producing vinegar using microorganisms with amplified copy number of DNA having the sequence shown in SEQ ID No. 1;

XII. Claim(s) 9, in part, drawn to a method of producing vinegar using microorganisms with amplified copy number of DNA that hybridizes to DNA having the sequence shown in SEQ ID No. 1;

XIII. Claim(s) 9, in part, drawn to a method of producing vinegar using microorganisms with amplified copy number of DNA having the sequence shown in SEQ ID No. 3; and

XIV. Claim(s) 9, in part, drawn to a method of producing vinegar using microorganisms with amplified copy number of DNA that hybridizes to DNA having the sequence shown in SEQ ID No. 3.

In response to the Official Action dated July 18, 2006, in which pending claims 1-10 were subjected to an election, applicants provisionally elect to prosecute the DNA claims of **Group II (claims 2, 3, and 10)**. Applicants respectfully disagree with the restriction requirement imposed by the Examiner and the characterizations made of the claimed invention. Accordingly, as is set forth in detail below, this election is made with traverse.

It is the Examiner's position that restriction is appropriate because the groups contain claims that are independent or distinct. Applicants respectfully disagree with the Examiner's position. Applicants respectfully submit that the Requirement for Restriction is improper for at least the reasons stated, and request that the Restriction Requirement be withdrawn and all presented claims be examined on the merits.

According to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; **and**
- (2) There must be serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that (1) the groups of the restricted claims are properly presented in the same application; (2) undue diverse searching would not be required; and (3) all claims should be examined together.

The Examiner has not shown that examination of all the pending claims would require undue searching and/or place a serious burden on the Examiner, which is a requisite showing for proper issuance of a restriction requirement. In fact, applicants submit that to properly search any one group, the other groups must be considered as well to perform a comprehensive search.

At the very least, restriction is improper between Groups II and III since the DNA and its full complement should be examined together. According to MPEP 806.05(j),

the inventions are distinct if

- (A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions *as claimed* are not obvious variants; and

(C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

Moreover, claim 2 is directed to DNA a) encoding the protein of claim 1 and b) having a complementary DNA sequence of claim 3. The claims of Groups I-III are not only related but are linked as written. Under MPEP §809, related and linked claims should be examined together. Furthermore, the DNA of claim 2 further links the microorganisms of claims 7 and 8, method of using the microorganisms of claim 7 or 8 in claim 9, and recombinant plasmid of claim 10. Thus, the claims of Groups 7, 11 and 12 should be combined and examined with those of Groups 1-3 since these claims are all related and it would not be unduly burdensome for the Examiner to perform a search to the claims DNA, the protein it encodes, the microorganisms that include the DNA, method of using the microorganisms with the DNA, and a recombinant plasmid including the DNA.

With all due respect, applicants disagree that the Examiner's requirement is proper. However, in order to facilitate prosecution and to avoid a holding of non-responsiveness in this application, applicants elect the claims of Group II with traverse. In the event that the Examiner does not withdraw the restriction requirement, applicants expressly reserve the right to timely file divisional applications directed to the presently non-elected subject matter.

An examination of all of the claims and the issuance of an Official Action on the merits of all of the pending claims are thus respectfully requested.

Early and favorable action by the Examiner is earnestly solicited.

CONCLUSION

If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the applicants' representative at (212) 415-8517. Applicants' representative may also be contacted by e-mail at the address of ekwon@morganfinnegan.com.

AUTHORIZATION

No additional fee is believed to be necessary. However, the Commissioner is hereby authorized to charge any additional fee(s) which may be required for this response, or to credit any overpayment to Deposit Account No. 13-4500, Order No. 4439-4024.

In the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4439-4024.

Respectfully submitted,
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Dated: September 15, 2006

By:



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